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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,944	11/18/2003	Mike Pell	13768.453	4451

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EXAMINER

BALAOING, ARIEL A

ART UNIT

PAPER NUMBER

2683

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,944

Applicant(s)

PELL ET AL.

Examiner

Ariel Balaoing

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 6-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-5, drawn to selection of information to be delivered to a mobile user, classified in class 455, subclass 414.1.
 - II. Claims 6-17, drawn to customizing multiple objects for display, classified in class 715, subclass 765.
 - III. Claims 18-35, drawn to tracking a plurality of users and tracking of computer and telephone usage, classified in class 715, subclass 789.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II/III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as selecting information to be delivered to a mobile user and determination if mobile user is online. See MPEP § 806.05(d).
3. Inventions II and I/III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as defining a plurality of views dependant on user settings. See MPEP § 806.05(d).
4. Inventions III and I/II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be

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separately usable. In the instant case, invention III has separate utility such as tracking computer and telephone usage from a plurality of users. See MPEP § 806.05(d).

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Jens Jenkins (Reg. 44803) on September 7, 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-5. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-35 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Oath/Declaration

8. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because Applicant has not given a post office address anywhere in the application papers as required by 37 CFR 1.33(a), which was in effect at the time of filing of the oath or declaration. A statement over applicant's signature providing a complete post office address is required.

Specification

9. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

10. Claims 1-5 are objected to because of the following informalities: the limitation “the physical location of the mobile user” is recited on line 4 of claim 1, this should read “a physical location of the mobile user”. Appropriate correction is required.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1- 5 are rejected under 35 U.S.C. 102(e) as being anticipated by SHTEYN et al (US 6,782,253 B1).

Regarding claim 1, SHTEYN discloses a method of selecting information to be delivered to a mobile user (abstract), the method comprising: determining that a mobile user is online (column 3:lines 1-16); receiving information identifying the physical location of the mobile user (202-Figure 2; column 7:lines 12-61); retrieving a time indicator (202-Figure 2; column 7:lines 12-61); retrieving aggregate user preference data (column 3:lines 1-16; column 3:line 52-column 4:line 17; column 7:lines 12-61); selecting information to be communicated to the user based on

the physical location of the user, the time, and aggregate user preference data (column 7:lines 12-61).

Regarding claim 2, see the rejections of the parent claim concerning the subject matter his claim is dependant upon. SHTEYN further discloses further comprising rendering the information to be provided to the mobile user (column 10:lines 6-60), and sending the rendered information to a mobile browser of a mobile communications device associated with the mobile user (column 10:lines 6-60).

Regarding claim 3, see the rejections of the parent claim concerning the subject matter his claim is dependant upon. SHTEYN further discloses further comprising sending the information to a mobile carrier [GSM cellnet] to be pushed to a mobile communications device associated with the mobile user (column 4:line 38-line 45; column 8:line 59-column 9:line 24).

Regarding claim 4, see the rejections of the parent claim concerning the subject matter his claim is dependant upon. SHTEYN further discloses wherein rendering the information is based at least in part on an identification of the mobile communications device (column 11:line 28-column 12:line 4; also, it is inherently necessary to provide the mobile ID when sending/receiving requested services in order to provide the information solely to the requesting mobile device).

Regarding claim 5, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. SHTEYN further discloses further comprising: retrieving a user profile associated with the mobile user (column 7:lines 12-61); wherein selecting information to be communicated to the user is further based on the user profile (column 7:lines 12-61).

Conclusion

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13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

DAHME et al (US 2001/0014615 A1) – Visual interface to mobile subscriber account services


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ariel Balaoing whose telephone number is (571) 272-7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 AM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ariel Balaoing
Art Unit 2683
Patent Examiner

AB


WILLIAM TROST
SUPERVISORY PATENT EXAMINER
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